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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,428	10/24/2001	Kenneth J. Cool	450.323US1	4637

32719 7590 03/26/2003

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT PAPER NUMBER

2643

DATE MAILED: 03/26/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Am

Office Action Summary

Application No.

10/042,428

Applicant(s)

Kenneth J. Cool

Examiner

Melur. Ramakrishnaiah

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 16, 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-23, and 25-30 is/are rejected.
- 7) ☒ Claim(s) 5, 15, and 24 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 12, 13, 20, 21, 22, 27-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni et al. (US PAT: 6,141,058, hereinafter Lagoni) in view of Isaka (US PAT: 5,706,388) and Goldwasser et al. (US PAT: 5,241,428, hereinafter Goldwasser).

Regarding claim 1, Lagoni discloses a system for uninterrupted viewing of a real time program during a telephone call to a user comprising: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 12-13, and 20, Lagoni further discloses a system for providing uninterrupted viewing of a real time program during a telephone from a caller to a user, the system comprising: means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), means (110, fig. 1) for detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

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Regarding claims 21-22, Lagoni further discloses an integrated system for providing for providing uninterrupted viewing of a real time program during a telephone from a caller to a user, comprising: a display in (158, fig. 1) capable of displaying the program and caller identification information upon receipt of the call (col. 4 lines 4-9), a speaker (136, fig. 1) capable of audio output for the program and the call (51-53), a microphone (not shown) capable of accepting audio input for the call, a user input device (125, fig. 1) for controlling the viewing of the program (col. 4 lines 41-43, col. 5 lines 61-63) and for accepting and terminating the call, controller (110, fig. 1) capable of detecting and termination of the call by the user (this step is implicit in view of step 530 in fig. 5).

Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.

However, Isaka discloses recording system which teaches the following: : a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5).

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Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Lagoni's system to provide for the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system.

Regarding claims 2-3, 27-30, Lagoni further teaches the following: display coupled to the buffer and further capable of displaying buffered program to the user (fig. 3, col. 4 lines 33-43), means (158, fig. 1) for displaying caller identification data from the incoming telephone call to assist the user in selecting whether to answer the incoming phone call, detecting means (110, fig. 1) further comprises displaying caller identification data from the incoming phone call when the caller identification data matches a predetermined list, the caller identification data displaying means otherwise not displaying the caller identification data, displaying caller identification data from the incoming phone call to assist the user in selecting whether to answer the incoming phone call, displaying caller identification data matches a predetermined list, the displaying means otherwise not displaying the caller identification data (fig. 5, col. 4 lines 55-67, col. 5 lines 1-18).

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3. Claim 4, 6-9, 14, 16-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP02001028645A, hereinafter Natori)

Regarding claims 4 and 14, the combination teaches the following: a memory for storing data about the call, the data including the caller identification data about the call (col. 4 lines 64-67 of , '058); but it does not teach storing the length of the call.

However, Natori discloses information device which teaches storing length of call (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for storing length of call as this arrangement would provide call history for the user for referencing it when required as taught by Natori.

Regarding claims 6-9 and 16-19, the combination teaches the following: capable of storing a caller list, the caller list being generated based on the stored data about the call, caller included in the caller list if the stored data about the call indicates that at least a predetermined percentage of the caller's call were accepted by the user (this is implied by the priority caller list, note: col. 4 lines 19-32), caller identification is displayed only if the caller is included in the caller list, automatically accepting the call if the caller is included in the caller list (col 2 lines 1-9).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP406319173A).

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Regarding claim 10, the combination does not explicitly teach the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user.

However, Tsutsumi discloses a remote controller serving as a telephone set which teaches the following: input device (3, fig. 1) for controlling viewing of the program and for accepting and terminating the caller by the user (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user as this arrangement would enable the user to answer the call without going to the place of handset by using the remote controller as taught by Tsutsumi.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Lund (US PAT: 6,342,270 B1, filed 7-13-1998).

Regarding claim 11, the combination does not teach the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user.

However, Lund discloses system and coordination of electronic devices which teaches the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user (col. 2 lines 36-48).

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Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user as this would enable the user to answer the telephone call without being distracted by television audio as taught by Lund.

6. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP403178247A, hereinafter Shimada) and Tamura et al. (JP404112374A, hereinafter Tamura).

Regarding claims 25, the combination does not teach the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call.

However, Shimada discloses television communication equipment which teaches the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call (fig. 1, see abstract).

Regarding claim 26, the combination does not teach the following: voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means.

However, Shimada discloses voicemail system integrated with in the recording means (11, fig. 1) and Tamura teaches voicemail system external to the recording means in (11, fig. 1).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: voicemail system to handle

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incoming phone call in the event the user does not answer the incoming phone call as this arrangement would facilitate to record messages when user is unable to answer the call as taught by Shimada; voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means as this arrangement would facilitate storage facilities for messages at different locations to suite users requirements when the user is unable to answer the call as taught by Shimada and Tamura.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831, hereinafter Schultheiss).

Regarding claim 23, the combination does not teach the following: recording means comprises a structure selected from the group consisting of: set to box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television.

However, Schultheiss discloses method and systems for providing television related services via networked personal computer which teaches the following: recording means comprises a structure selected from the group consisting of: set to box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television (fig. 1, page 8 line 18 to page 9 line 15).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: recording means comprises a structure selected from the group consisting of: set to box, a computer system, satellite receiver, a

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cable receiver, an Internet television box, a network client, and a television as this arrangement would provide varied structure to control and record information as taught by Schultheiss, thus enhancing the usefulness of the system.

8. Claims 5, 15, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed on 1-16-2003 have been fully considered but they are not persuasive.

Rejection of claims 1-3, 12, 13, 20, 21, 22, 27-30, under 35 U.S.C. 103(a) as being unpatentable over Lagoni et al. (US PAT: 6,141,058, hereinafter Lagoni) in view of Isaka (US PAT: 5,706,388) and Goldwasser et al. (US PAT: 5,241,428, hereinafter Goldwasser):

Regarding rejection of independent claims 1, 12, 13, 20-22, Applicant argues that rejection of these claims under 103(a) is based on hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant further argues that

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“Applicant traverses the assertion as it fails to explain how Lagoni would be modified to include the recording/reproducing system of Isaka. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03, and ... patent is respectfully requested. Regarding this, office action dated 10-25-2002, on pages 2-3 explains teachings provided by the primary reference Lagoni which teaches system for uninterrupted viewing of a real timer program during a telephone call to a user comprising: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5). Lagoni also teaches means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), and means (110, fig. 1) for detecting and terminal of a call by the user (col. 4 lines 10-17, also see step 530, fig. 5). However, Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.

However, Isaka discloses recording system which teaches the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the

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following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Lagoni's system to provide for the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system. Although office action dated 10-25-2002 explains this as set forth above, it appears that applicant does not want to acknowledge this. Further, In response to applicant's argument that "Applicant traverses the assertion (i.e obvious type rejection as stated above) as it fails to explain how Lagoni would be modified to include the recording/reproducing system of Isaka", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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Further, Applicant alleges that this explanation given above amounts to a form of official notice which is contrary to what is set forth in the office action. No where in the office action, Official notice is mentioned as alleged by the Applicant. Applicant further argues that “Applicant respectfully submits that the Examiner’s statement regarding a motivation to combine Lagoni with Isaka and Goldwasser is conclusory because the examiners statements are analogous to those made by the Examiner ... *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)”. Applicant further argues that “Applicant can not find any teaching or suggestion in Lagoni relating to recording program data, in addition, there is no teaching or suggestion in Isaka related to displaying caller data as part of the reproducing and recording system”. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lagoni teaches the following: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5). Lagoni also teaches means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), and means (110, fig. 1) for detecting and terminal of a call by the user (col. 4 lines 10-17, also see step 530, fig. 5) and Isaka and

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Goldwasser teaches the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5). One of ordinary skill in the art at the time invention was made would be motivated to combine teachings of Lagoni with Isaka and Goldwasser to reject Applicant's claim limitations as recited in independent claims 1, 12, 13, 20-22, because the combination facilitates to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system.

Applicant further argues that "Applicant respectfully requests that the Examiner provide some prior art that teaches or suggests utilizing and/or displaying caller identification information upon receipt of a call in combination with:". Applicant then lists claim limitations of independent claims 1, 12, 13, 20-22. Regarding this, Applicant's attention is directed towards explanation provided above regarding rejection of the claims 1, 12, 13, 20-22 under 35 U.S.C 103(a).

Rejection of claims 4, 6-9, 14, 16-19, under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP02001028645A, hereinafter Natori): Regarding rejection of these claims, Applicant argues about motivation to combine Lagoni in view of Isaka and Goldwasser and further in view

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of Natori. As stated in the office action of 10-25-2002, regarding claims 4 and 14, the combination of Lagoni, Isaka and Goldwasser teaches memory for storing data about the call, the data including the caller identification data about the call (col. 4 lines 64-67 of '508) and it does not teach storing length of the call. But it is old and well known to store length of the call in connection with telephone calls as taught by Natori. One of ordinary skill in the art at the time invention was made would be motivated to apply teachings of the Natori in the above combination to provide call history for the user for referencing it when required as taught by Natori.

The limitation of the claims 6-9, and 16-19 is taught by the combination of Lagoni, Isaka and Goldwasser as set for the in the office action above.

Regarding rejection of claims 10, 11, 25-26, 23 under 35 U.S.C 103(a) using combination of references as set forth in the office action above, Applicant's arguments are directed towards motivation to combine the references. As set forth in the office action above, motivations and reasons to combine are clearly set for in the office action above.

In view of the above explanation, rejection of claims 1-4, 6-14, 16-23, 25-30 is maintained as set forth in the office action above.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on Monday to Friday from 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).


Melur. Ramakrishnaiah

PRIMARY EXAMINER

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